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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/982,136 | 10/12/2001 | Wolfgang Reik | 3191/OJ838 | 7044 |
| 7278 | 7590 | 10/13/2004 | EXAMINER | |
| DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257 | | | SMITH, JULIE KNECHT | |
| ART UNIT | | PAPER NUMBER | | 3682 |

DATE MAILED: 10/13/2004

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/982,136

Filing Date: October 12, 2001

Appellant(s): REIK ET AL.

MAILED

OCT 13 2004

Edward J. Ellis

GROUP 3600

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/8/04.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-5 and 7-16 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

| | | |
|-----------|-----------------|---------|
| 5,267,488 | Hardeman et al. | 12-1993 |
| 4,719,812 | Machida et al. | 1-1988 |
| 5,566,591 | Burkett | 10-1996 |

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-5, 7-8 and 6-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hardeman et al. (5,267,488) in view of Machida et al. (4,719,812). This rejection is set forth in a prior Office Action, mailed on 1/13/04.

Claims 9-11 rejected under 35 U.S.C. 103(a) as being unpatentable over Hardeman et al. in view of Machida et al., as applied to claims 1-5, 7-8 and 6-12 above, and further in view of Burkett (5,566,591). This rejection is set forth in a prior Office Action, mailed on 1/13/04.

(11) Response to Argument

Appellant first argues that Hardeman et al. lacks a control device to control the clutch in an automated mode. The Examiner agrees that the Hardeman et al. reference lacks this feature, however, the rejections are not based upon 35 USC 102, but rather, are based on 35 USC 103. In order to teach the obviousness of controlling the clutch of Hardeman et al. in an automated mode, the examiner relies upon the teachings of Machida et al. Machida et al. teach to one of ordinary skill in the art the obviousness of operating a clutch in an automated mode (see col. 2, line 34 through col. 3, line 37) wherein at least portions of one of the clutch actuator device and control device are integrated into a carrier element (29, see col. 3, lines 62-68). Thus, it would have been obvious to one of ordinary skill in the art in view of the teachings of Machida et al. to include portions of at least one of the clutch actuator device and the control device in the carrier element of Hardeman et al. in order to automate actuation of the clutch. Appellant's reasoning is further based upon the argument that the elements 11-13 of Machida et al. are on the outside of the transmission. This is incorrect as the elements are located on a carrier element (29) attached to and extending into the transmission casing (28) of Machida et al. (see Fig. 7 and col. 3, lines 38-67).

Next, Appellant argues that the reference to Machida et al. does not address the problems solved by Appellant. Obviousness is not determined solely by whether or not the reference combination solves any stated problem; rather, it is determined by whether or not it would have been obvious to one of ordinary skill in the art to modify the primary reference to achieve the claimed invention. In the instant case, the issue is whether or not it would have been obvious to automate the clutch of Hardeman et al. in view of the teachings of Machida et al. As Machida et al. teach to one of ordinary skill in the art the automating of a clutch in the manner claimed, the reference combination is proper.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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JKS
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October 1, 2004

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